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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/595,798	06/16/2000	William J. Brosnan	IGT1P021/P-239	3320
22434	7590	03/14/2007	EXAMINER	
BEYER WEAVER LLP P.O. BOX 70250 OAKLAND, CA 94612-0250			MCCULLOCH JR, WILLIAM H	
		ART UNIT	PAPER NUMBER	
		3714		
SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE		
3 MONTHS	03/14/2007	PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)
	09/595,798	BROSNAN, WILLIAM J.
	Examiner	Art Unit
	William H. McCulloch Jr.	3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 03 January 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 27,28 and 38-56 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 27,28 and 38-56 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 16 June 2000 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. This action is in response to amendments received 1/3/2007. Claims 27-28 and 38-56 are pending in the application, with claims 27, 39, 42, 46, 49, and 52 currently amended.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 27, 28, 38-42, 44-53, and 55-56 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,913,531 to Yoseloff (hereinafter "Yoseloff").

Regarding claims 27 and 46, Yoseloff teaches a method for providing game downloading in a gaming system including the following elements (in the context of claim 27):

- (i) a first housing (e.g. a personal computer in 11:10-13 or apparatus in 12:52-13:11);
- (ii) a first master gaming controller coupled to the housing designed or configured to control a first game selected from a list of games

displayed on the first gaming machine (processor or microprocessor in 10:43-47, monitor or display device in 11:31-36);

(iii) one or more displays coupled to the first housing for displaying the first game controlled by the first master gaming controller or the list of games (monitor or display device in 11:31-36 or 12:52-13:11);

(iv) one or more first input devices coupled to the housing for accepting cash or indicia of credit wherein the cash or indicia of credit are for making wagers on the first game played on the first gaming machine (e.g. bet one credit button 10, currency or coin slot/acceptor 22, maximum bet button 26 in 12:60-64, or input devices in 11:22-28);

(v) a first communication interface connected to a network for communication with at least a second gaming machine (network interfaces in 11:61-12:11);

(vi) a first memory for storing executable coding instructions downloaded from the second gaming machine (e.g. drives and RAM storing downloadable program modules in at least 11:5-17; program modules are described in at least 10:20-30);

(vii) a first output device coupled to the first housing for outputting the cash or the indicia of credit (payout indicated in payout window, see at least 13:56-59; see also 7:57-61 and 8:10-20).

Yoseloff teaches that a second gaming machine is substantially the same or exactly the same as the first device in 11:44-46. The second machine in one embodiment is described as a "peer" device in 11:43. Additionally, both devices

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include an award mechanism to pay winnings to a player (see at least 7:57-61, 8:10-20, 13:56-59, and pay tables in columns 13-14). Furthermore, Yoseloff teaches that the game method may be implemented on numerous types of gaming devices, including those associated with a casino, having a network connection, and may include a bank of video gaming equipment, such as the type associated with a coordinated jackpot function (see at least 9:47-10:18 and 11:40-13:59):

The aforementioned program modules enable the gaming machine to load and execute a particular game, as shown in 10:20-42. The gaming devices would not be able to play a particular game unless they have available the executable coding instructions (or program) to process the corresponding information. Furthermore, Yoseloff teaches that the gaming devices may obtain the program modules by downloading them from a network, such as the Internet, in 11:5-17. Yoseloff teaches that downloading may be associated with a manual operation performed by a human operator (see at least 9:51-59). The recitation of "downloading" one or more program modules of a collection of available modules necessitates that a program module is selected for transfer by a user, at which point a signal indicating the selection is sent to a second gaming device to begin the information transfer (see *Id.*) Yoseloff does not use the term "list" of programs, but allows for multiple program modules to be downloaded under the control of the player. Therefore a list of program modules is inherently present in Yoseloff's system in order to allow the user of Yoseloff's gaming device to select a program module for download. The examiner notes that the functionality of

Yoseloff's system with regard to downloading program modules under the player's control could not function without a list from which the player chooses one or more modules to download.

Regarding claims 28, 40, 47, and 48-49, Yoseloff teaches games including slot games (see at least 8:10-20) and card games, such as known variations of poker (see at least 5:25-41). As described above, the first and second gaming machines may be substantially identical. Since the program code transferred between the machines becomes resident on both machines, the second gaming machine has the same games available for play as the first.

Regarding claims 38 and 50, the network embodiments are wired networks (see at least 11:61-12:11).

Claims 39 and 51 are directed toward a network comprising one or more wired or wireless connections, wherein one of the wired connections is a fiber optic connection. Yoseloff teaches transmitting program data over the global Internet, which is known to use fiber optic communication systems in network "backbones". Therefore, at least one of the wired connections in Yoseloff is a fiber optic connection.

Regarding claims 41 and 52, Yoseloff teaches embodiments of a bonus game (jackpot) or a progressive game (coordinated jackpot) in at least 11:53-60.

Regarding claims 42 and 53, as described in 10:27-30, Yoseloff teaches that program modules include code, applets, routines, programs, components, objects, and data structures, which anticipate the claimed software settings for the executable coding instructions.

Regarding claims 44 and 55, as described above, Yoseloff teaches that the program modules may contain various code segments that carry out the basic functions of the gaming system, indicating that one or more of the above are analogous to hardware settings. Further support comes from Yoseloff in 12:12-15, which states that the game control module within the video gaming apparatus is embodied in software, hardware, or a combination of both, indicating that in some embodiments the software settings and hardware settings are one in the same.

Regarding claims 45 and 56, the term "casino area network" is interpreted herein as a local or wide area network embodied in one or more casinos. A similar interpretation was made in a previous final rejection. Yoseloff teaches that the networking environments are commonplace in casinos (11:61-65). As described above, the gaming machines may participate in bonus or progressive play.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 43 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoseloff in view of U.S. 6,306,035 to Kelly et al. (hereinafter "Kelly").

Yoseloff teaches a gaming system substantially as described above.

Yoseloff further teaches that gaming machines may be spread across multiple gaming jurisdictions (11:53-60). Yoseloff lacks in specifically disclosing that the software settings transmitted from one gaming machine to another relate to gaming jurisdictions. In an analogous disclosure, Kelly teaches identifying gaming machines in particular gaming jurisdictions and altering game settings according to the individual jurisdictions (see at least 12:56-13:22). Kelly teaches that such individual jurisdictional settings would allow the invention to restrict access to certain games in accordance with local gambling laws. Therefore it would have been obvious to one of ordinary skill in the art at the time of invention to include jurisdictional data in the program modules of Yoseloff in order to operate within local laws, as favorably taught by Kelly.

Response to Arguments

6. Applicant's arguments filed 1/3/2007 have been fully considered but they are not persuasive.

On pages 8-9 of Remarks, applicant alleges that the examiner may be improperly implying inherency in the previous rejection relating to the selection of executable instructions from a list. The examiner has provided the proper factual evidence stemming from the Yoseloff reference in the current and previous rejection to support the argument that Yoseloff inherently teaches a player selects from a list of program modules to download. As stated in the rejection above, Yoseloff teaches that the gaming devices may obtain the program modules by downloading them from a network, such as the Internet, in 11:5-17.

Yoseloff teaches that downloading may be associated with a manual operation performed by a human operator (see at least 9:51-59). The recitation of "downloading" one or more program modules of a collection of available modules necessitates that a program module is selected for transfer by a user, at which point a signal indicating the selection is sent to a second gaming device to begin the information transfer (see *Id.*) Yoseloff does not use the term "list" of programs, but allows for multiple program modules to be downloaded under the control of the player. Therefore a list of program modules is inherently present in Yoseloff's system in order to allow the user of Yoseloff's gaming device to select a program module for download. The examiner notes that the functionality of Yoseloff's system with regard to downloading program modules under the player's control could not function without a list from which the player chooses one or more modules to download.

The examiner further notes that applicant has failed to properly challenge the inherency argument of the rejection. MPEP 2112 (IV) states, "ONCE A REFERENCE TEACHING PRODUCT APPEARING TO BE SUBSTANTIALLY IDENTICAL IS MADE THE BASIS OF A REJECTION, AND THE EXAMINER PRESENTS EVIDENCE OR REASONING TENDING TO SHOW INHERENCY, THE BURDEN SHIFTS TO THE APPLICANT TO SHOW AN UNOBlOUS DIFFERENCE...[T]he PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product. Whether the rejection is based on 'inherency' under 35 U.S.C. 102, on 'prima facie obviousness' under 35 U.S.C. 103, jointly or

alternatively, the burden of proof is the same...The burden of proof is similar to that required with respect to product-by-process claims. In re Fitzgerald, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980) (quoting In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977))."

On pages 9 and 10, applicant contends, "The embodiments in Yoseloff cited by the Examiner would not be recognized by one in the skill of the art as describing a download of software between two 'casino type' gaming machine." The examiner notes that applicant's claims are completely devoid of the word "casino". Conversely, the Yoseloff reference teaches copious embodiments of gaming systems that are explicitly described for use in casinos (see at least 9:47-10:18 and 11:40-13:59).

In view of the above explanations, the rejection is deemed proper.

Citation of Pertinent Prior Art

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. 6,935,946 to Yoseloff describes a video gaming apparatus for wagering with universal computerized controller and I/O interface for unique architecture. The examiner notes that this reference is incorporated in U.S. 6,913,531 to Yoseloff, used in the rejection above.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is

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filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William H. McCulloch Jr. whose telephone number is 571-272-2818. The examiner can normally be reached on M-F 8:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on 571-272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

William H. McCulloch Jr.
Examiner
Art Unit 3714
3/9/2007



wm



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PRIMARY EXAMINER